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EXAMINER

TARAE, CATHERINE MICHELLE

ART UNIT PAPER NUMBER

3623

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,611

Applicant(s)

PERRY ET AL.

Examiner

C. Michelle Tarae

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,8,12-18,22-26 and 28-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,8,12-18,22-26 and 28-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Final Office Action in response to the communication received on September 6, 2006.

Claims 1, 3-4, 7-8, 12-18, 22-26 and 28-58 are now pending.

Response to Amendment

2. No claims have been amended.

Response to Arguments

3. Applicant's arguments have been fully considered, but are found unpersuasive.

In the Remarks, Applicant argues the following: 1) Belcsak et al. does not teach the selecting step of claim 1; and 2) Belcsak et al. does not teach outputting a report displaying responses to at least one of the questions as recited in claim 1.

In response to argument 1), Examiner respectfully disagrees. In col. 1, lines 22-30, Belcsak et al. discloses that the invention is directed to a modeling tool that analyzes various aspects of a *proposed* financial arrangement between parties to the transaction and prepares and *structures* the financial proposals in an optimal manner. In col. 4, lines 29-37, Belcsak et al. further discloses the financial modeling tool *allowing a user to select and use one or more of the predefined instruments* during creation of the financial scenario, where a financial instrument is disclosed as encompassing advanced corporate finance operations such as mergers, acquisitions and the like in col. 11, lines 59-62. Figure 3 illustrates the process in which a user has the option to

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add more instruments before creating the proposed financial model. Therefore, Examiner respectfully submits Belcsak et al. does teach the selecting step of claim 1. In response to argument 2), Examiner respectfully disagrees. In col. 2, lines 1-3, Belcsak et al. discloses a graphical user interface that generates information relating to a particular financial transaction or scenario *in response to inputs from a user*. In col. 3, lines 20-30 and 60-64; col. 7, lines 48-56, is disclosed allowing the user to enter scenario specific data (i.e., answer questions about the proposed financial structure) to generate and display contents of the proposal, including the financial structure of the proposal, flows of money and assets, parties involved, timelines, etc. Once a proposed financial scenario is optimized, a report is generated displaying the contents of the proposed financial scenario, where the contents were created from the inputs received from the user (see Figure 2; col. 7, lines 62-67). Therefore, Examiner respectfully submits Belcsak et al. does teach outputting a report displaying responses to at least one of the questions as recited in claim 1.

In conclusion, Applicant's arguments have been fully considered, but are found unpersuasive. Accordingly, the rejections are maintained and repeated below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-4, 7-8, 12-18, 22-26 and 28-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belcsak et al. (U.S. 6,957,191).

As per claim 1, Belcsak et al. discloses a method of preparing and evaluating a business proposal, comprising the steps of:

displaying a plurality of questions relating to the proposal, including proposal components, proposal characteristics, risks, revenue drivers, investment bases, and a business environment (col. 2, lines 7-11; col. 3, lines 19-24; col. 7, lines 47-57; items 30, 32 and 34 in Figure 2; Users use an interactive interface, such as a CAD interface, to manipulate displayed data to generate contents of a proposal, where the displayed data includes the financial structure of the proposal, flows of money and assets, parties involved, and various scenarios for the proposal.);

allowing access to a database of client information and a database of proposer information (col. 30, lines 12-42; col. 33, lines 23-30; col. 35, lines 6-19; The database maintains all parameters essential to the proposal generation and analysis, where the parameters identify everything from party involved to cash classification.);

receiving answers to the plurality of questions based on information accessed in the databases (col. 6, lines 49-55; col. 8, lines 13-27; The engine receives input from a user, where the input answers questions relating to all the aspects of a proposal.);

defining a query for search criteria for the proposal and performing a search based on the query and answers to the questions (col. 14, lines 37-53; col. 14, line 66- col. 15, line 27; col. 24, lines 30-33; col. 32, lines 32-49; The optimization engine allows user to define a search query by inputting objectives and constraints for the proposal.

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The optimization engine then applies the inputs to an optimization model and outputs the results to the user.);

storing information relevant to the proposal gathered in the search (col. 15, lines 40-41; col. 21, lines 53-60; Data including decision variables and parameter constraints for each structure and outcome is saved.);

selecting at least two alternative structures between a purchaser and a provider selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership and a venture (col. 7, lines 6-9 and 29-35; col. 10, lines 14-36; col. 11, lines 59-62; Users may view alternative structures (i.e., instruments) and manipulate decision variables to change the outcomes for the structures.);

evaluating the stored information by computer (col. 21, lines 43-52 shows an example in which two alternative outcomes are evaluated.); and

reevaluating information sources and a business environment relative to the proposal and reevaluating organizational and proposal considerations, and risks relative to the proposal; reconsidering at least one of the alternative structures and optionally reshaping at least one of the alternative structures; and reevaluating the at least two alternative structures (col. 3, lines 60-64; col. 4, lines 10-15 and 24-37; col. 8, lines 27-50; Figure 2; The user may interact with the optimization engine and add/modify different scenario parameters and constraints for reevaluation.).

While Belcsak et al. discloses evaluating two alternative structures to optimize the proposal based on certain parameters and constraints and displaying the results of the optimization (col. 3, lines 10-34; col. 4, lines 24-37; col. 24, lines 30-58; col. 25, lines

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2-13), Belcsak et al. does not expressly disclose ranking the two alternative structures based on the evaluation of the stored information and displaying the rankings.

However, since the optimization engine evaluates parameters and constraints associated with structures and then optimizes the structures based on the user's goals, the optimization engine, in essence, must perform some type of internal ranking in order to determine which scenarios provide the best deal to the user. Additionally, it is old and well known to display rankings to a user who is making a decision based on the rankings as visual rankings provide the benefit to the user of an easily quantifiable analysis. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to have the optimization engine of Belcsak et al. display the rankings of the alternative structures after it performs its internal optimization or ranking based upon the user's indicated goals in order to provide the user with a visual indication with which to easily discern which scenarios are best for the user.

As per claim 3, Belcsak et al. discloses the method of claim 1, wherein the step of displaying a plurality of questions comprises displaying predetermined questions on at least one template stored in a computer and wherein the step of receiving the answers to at least one predetermined question calls up for display at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 8, lines 13-27; col. 12, lines 29-34; col. 16, lines 50-58; Stored templates, or canned instruments, are activated when the user indicates that the proposal will include a particular financial instrument or transaction, where the canned

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instruments include a set of required inputs/calculations related to the particular instrument or transaction that the user must provide.).

As per claim 4, Belcsak et al. discloses the method of claim 1, wherein the proposals are evaluated by calculating at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (col. 8, lines 2-6).

As per claims 7 and 15-17, Belcsak et al. does not expressly disclose the method of claim 1, further comprising displaying the rankings with a graphical user interface or that the ranking include numbers, the analysis of which is provided above in claim 1.

As per claim 8, Belcsak et al. does not expressly disclose the method of claim 7, wherein the rankings are presented in a Harvey-ball format. However, the Harvey-ball format is an old and well known display format that uses moon phases to indicate association levels of an item based on certain criteria. The Harvey-ball format provides a quick and easy way for a user to view compare items based on certain criteria. At the time of the invention, it would have been obvious to a person of ordinary skill in the art for Belcsak et al. to display rankings of items using a Harvey-ball format because such a display would provide users with a quick and easy means for assessing the rankings.

As per claims 12 and 13, Belcsak et al. discloses the method of claim 1, wherein the answers are input to the computer through a graphical user interface by choosing selections from at least one of a drop-down screen, a scroll screen, a check box, and a list box (Figures 5-12 and 14-23).

As per claim 14, Belcsak et al. discloses the method of claim 1, wherein the proposal comprises an offer of a service from the provider, and further comprising the step of calculating a way to pay for the proposal (col. 7, lines 6-9 and 29-35; col. 9, lines 30-34; col. 19, lines 22-49; An example of leasing a plane is provided in which the lessee has the option to buy the plane. Rental agreements are another example of providing a service and determining how payment will occur.).

As per claim 39, Belcsak et al. discloses the method of Claim 1, wherein the alternative structures between the purchaser and the provider differ in an amount of equity owned by the purchaser and the provider (col. 19, lines 1-36; An example discusses scenarios that compare when a lessor own equipment versus when the lessee owns equipment.).

As per claim 40, Belcsak et al. discloses the method of Claim 1, wherein an advantage of at least one of the structures is creation of an asset (col. 19, lines 1-36; When the ownership of equipment transfers to a party, that is a creation of an asset to that party.).

As per claim 41, Belcsak et al. discloses the method of Claim 1, wherein the provider furnishes information to the purchaser demonstrating a difference in value to the purchaser based on the alternative structures (col. 14, line 64-col. 15, line 6; col. 19, lines 1-36; The agreement regarding transferring ownership of equipment includes buyout parameters as well as tax implications, thus demonstrating different values to each party.).

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As per claim 42, Belcsak et al. discloses the method of Claim 1 wherein at least one of cost drivers and revenue drivers is used to evaluate and rank the structures (col. 14, line 64-col. 15, line 6).

As per claim 43, Belcsak et al. discloses the method of Claim 1, wherein the values of the at least two alternative structures are calculated as revenue streams to the purchaser (col. 24, lines 39-42).

As per claim 44, Belcsak et al. discloses the method of Claim 1, wherein the values of the at least two structures are calculated as at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value (col. 8, lines 2-6).

Claims 18, 22-26, 28-38, 45-58 recite substantially similar subject matter as claims 1, 3, 4, 7, 8, 12-17 and 39-44 above. Therefore, claims 18, 22-26, 28-38, 45-58 are rejected on the same basis as claims 1, 3, 4, 7, 8, 12-17 and 39-44.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Belcsak et al. (U.S. 2005/0182709) discusses a modeling tool for structuring financial proposals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "C. Michelle Tarae", written in a cursive style.

C. Michelle Tarae
Patent Examiner
Art Unit 3623

November 20, 2006